

## **REMARKS**

### **I. Introduction**

Claims 1 and 2 are pending in the application.

The Examiner rejected claims 1 and 2 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

Claims 1 and 2 were also rejected by the Examiner under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,640,304 to Ginter et al. (hereinafter, "Ginter").

### **II. The Rejection Under 35 U.S.C. § 112, Second Paragraph**

The Examiner rejected claims 1 and 2 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. The Examiner's rejection is respectfully traversed.

In *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1320-21 (Fed. Cir. 2003), the U.S. Court of Appeals for the Federal Circuit set forth the standard for determining "definiteness" under 35 U.S.C. § 112, second paragraph, as follows:

As mandated by the definiteness requirement of the Patent Act, a specification must conclude with claims "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." 35 U.S.C. § 112, ¶ 2 (2000). Determining whether a claim is definite requires an analysis of "whether one skilled in the art would understand the bounds of the claim when read in light of the specification.... If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more." *Miles Labs., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875, 27 USPQ2d 1123, 1126 (Fed. Cir. 1993).

Similarly, in *Morton Int'l, Inc. v. Cardinal Chemical Co.*, 5 F.3d 1464, 1470 (Fed. Cir. 1993), the court explained that "[w]hether a claim is invalid for indefiniteness requires a determination whether those skilled in the art would understand what is claimed when the claim is read in light of the specification" (citation omitted). See also *Miles Labs., Inc. v. Shandon Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993) (explaining that "[t]he test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification") (citation omitted).

Moreover, the Manual of Patent Examining Procedure, Eighth Edition (“MPEP”), similarly states that compliance with 35 U.S.C. § 112, second paragraph, merely requires that applicants’ claims, “interpreted in light of the disclosure, must reasonably apprise a person of ordinary skill in the art of the invention.” MPEP § 2106(V)(A)(2). *See also* MPEP § 2173.02 (stating that, “[i]n reviewing a claim for compliance with 35 U.S.C. 112, second paragraph, the examiner must consider the claim as a whole to determine whether the claim apprises one of ordinary skill in the art of its scope”). Further, with respect to new terms, such as the term “electronic security value units” used by applicants in claim 1, the MPEP explains that “[t]he requirements for clarity and precision must be balanced with the limitations of the language and the science.” MPEP § 2173.05(a)(II).

In light of the above, applicants respectfully submit that claims 1 and 2 are in full compliance with the “definiteness” requirement of 35 U.S.C. § 112, second paragraph, given that the bounds of these claims are sufficiently clear to those skilled in the art when these claims are read in light of the specification. With regard to applicants’ use of the new term “electronic security value units,” which appears to be the Examiner’s only basis for the rejection of claims 1 and 2 under this section,<sup>1</sup> it is respectfully submitted that the meaning of this term is sufficiently clear. For example, as described throughout applicants’ specification, accesses to a resource in an electronic system are controlled (and monitored) using “electronic security value units” by requiring an appropriate amount of this “currency,” which is not representative of real money, to be given (paid) in exchange for each access to a resource. Thus, as stated on page 26, lines 19-21 of the specification, “electronic security value units may be viewed as a type of currency which is used to pay for access from a security point of view.” Moreover, unlike real money, “electronic security value units” may be “minted” by the system as explained, for example, on page 14, lines 21-22 of the specification.

Accordingly, because the use of “electronic security value units” does not render the bounds of either of claims 1 or 2 unclear, and because the Examiner has not set forth any other basis for rejecting these claims under this section, applicants respectfully submit that claims 1 and 2 are definite under 35 U.S.C. § 112, second paragraph.

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<sup>1</sup> The Examiner only refers to this term towards the end of the rejection, found at page 3 of the Office Action. However, in light of a full reading of the Examiner’s arguments, it is believed by applicants that the use of

Moreover, applicants respectfully submit that the authority cited by the Examiner does not support his proposition that claims 1 and 2 are indefinite under 35 U.S.C. § 112, second paragraph. For example, in rejecting the claims under this section, the Examiner, citing to MPEP § 2106,<sup>2</sup> stated that “[i]n order to define/redefine a term, the Applicant must do so ‘with reasonable clarity, deliberateness, and precision’ and must ‘set out his uncommon definition in some manner within the patent disclosure so as to give one of ordinary skill in the art notice of the change’ in meaning” (Office Action, page 3). Applicants respectfully submit that the only portion of the MPEP that includes the quoted language is § 2111.01(III), and that the quoted language refers to the criteria set forth in the MPEP for rebutting the presumption that claim terms are to be given their ordinary and customary meaning. This criteria, however, is irrelevant to determining the “definiteness” of claims 1 and 2 under 35 U.S.C. § 112, second paragraph.

Similarly, applicants respectfully submit that the Examiner’s reliance on *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1352 USPQ2d 1029 (Fed. Cir. 1999) on page 2 of the Office Action is also misplaced. This case, like the portion of the MPEP cited by the Examiner, relates to the issue of using terms in a manner contrary to or inconsistent with one or more of their ordinary meanings, and not whether claims are “definite” under 35 U.S.C. § 112, second paragraph.

Further, in rejecting the claims under this section, the Examiner asserted that “[t]he phrase ‘electronic security value units’ in claims 1 and 2 renders those claims indefinite because the claim language does not clearly define the term” (Office Action, page 3). In support of this assertion, the Examiner has apparently relied on *In re Van Geuns*, 988 F.2d 1181, USPQ2d 1057 (Fed. Cir. 1993), which addressed the inappropriateness of importing limitations from the specification to the claims. However, applicants respectfully submit that the issue of importing limitations from the specification into the claims is inapposite to that of determining definiteness of claim terms using the specification, the latter of which is not only permissible, but in fact mandated. See, e.g., MPEP § 2106(V)(A)(2), which explains that “the definiteness of [claim] language must be analyzed, not in a vacuum, but always in light of the teaching of the disclosure

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“electronic security value units” in claim 1 is the sole basis for the Examiner’s rejection under 35 U.S.C. § 112.

<sup>2</sup> Although the Examiner does not clearly indicate that the quoted portion of the MPEP is derived from this section, applicants presume this to be the Examiner’s contention given that no other section of the MPEP is referred to in rejecting the claims under this section.

as it would be interpreted by one of ordinary skill in the art” (emphasis added). *See also* MPEP § 2173.05(a)(I) (explaining that new terminology being used in the claims should “be apparent from the prior art or from the specification and drawings at the time the application is filed”) (emphasis added).

For at least the foregoing reasons, applicants respectfully submit that the bounds of claims 1 and 2 are clear, and request that the Examiner withdraw the rejection of claims 1 and 2 under 35 U.S.C. § 112, second paragraph.

### **III. The Rejection Under 35 U.S.C. § 102(e)**

The Examiner rejected claims 1 and 2 under 35 U.S.C. § 102(e) as being anticipated by Ginter. The Examiner’s rejection is respectfully traversed.

Applicants’ independent claim 1 relates to a method for monitoring accesses to a resource in an electronic system, wherein access to the resource is based on payments in electronic security value units. As amended, independent claim 1 includes the following features:

- detecting patterns of payments for said resource in electronic security value units; and
- comparing said patterns of payments to predetermined patterns of payments.

Contrary to the Examiner’s assertion on pages 3-4 of the Office Action, however, Ginter does not show or suggest applicants’ independent claim 1 for at least the following reasons:

#### **(A) Ginter Does Not Disclose The Detection Of Patterns As Claimed**

The portions of Ginter cited and discussed by the Examiner do not disclose the detection of patterns of payments for a resource. Rather, these portions merely relate to detecting and tracking events, charging for events, and limiting content usage. For example, as explained in Ginter at column 58, line 24 through column 59, line 2:

The “events process” 402 detects things that happen (“events”) and determines which of those “events” need action by other “processes.” The “events” may include ... a request to use content ... [and whether] an “event” needs more processing depends on the “rules and controls” corresponding to the content....

“Meter” process 404 keeps track of events, and may report usage to distributor 106 and/or the appropriate VDE participant(s)....

Billing process 406 determines how much to charge for events....

Budget process 408 limits how much content usage is permitted... [and]

Content may be supplied to the user once these processes have been successfully performed.

Thus, Ginter discusses processes that must be performed in connection with supplying content to a user (for example, to ensure that proper payment of real money is received for a user's access to, or use of, a product). However, nowhere in this or any other portion of Ginter is "detecting patterns of payments for [a] resource" (as recited in claim 1, emphasis added) ever shown or suggested. For example, with respect to the Examiner's reference to "event process" 402 of Ginter (*see* Office Action, page 3), applicants respectfully submit that this process merely detects things that happen (referred to as "events"), and determines whether action by other processes is required (*e.g.*, whether a billing process should be used to charge a user). Event process 402 does not in any manner detect payment patterns in connection with a resource, nor does it invoke any other process that performs such detection.

Moreover, applicants respectfully submit Ginter's disclosure of detecting "patterns of use that may or do indicate fraud" in column 227, lines 11-23 is not the same as detecting "patterns of payments" as recited in claim 1. Rather, as made clear by Ginter's goal of detecting "acquisition of protected content without any corresponding payment" (Ginter, column 227, lines 16-17, emphasis added), detecting "patterns of use" does not mean that there has been a corresponding payment. Thus, detecting "patterns of use" is not the same thing as detecting "patterns of payments."

Therefore, Ginter does not show or suggest a method for monitoring accesses to a resource including, among other things, "detecting patterns of payments for said resource in electronic security value units" as claimed in independent claim 1.

**(B) Ginter Does Not Disclose Comparing Payment Patterns As Claimed**

As explained immediately above, Ginter does not disclose detecting "patterns of payments." For at least this reason, Ginter must also fail to disclose "comparing patterns of payments to predetermined patterns of payments" as recited in claim 1.

Moreover, the portion of Ginter quoted on page 4 of the Office Action does not support the Examiner's assertion to the contrary. This portion of Ginter, at column 227, lines 11-23,<sup>3</sup> states the following:

Finally, the end-to-end nature of VDE applications, in which content 108 flows in one direction, generating reports and bills 118 in the other, makes it possible to perform "back-end" consistency checks. Such checks, performed in clearinghouses 116, can detect patterns of use that may or do indicate fraud (e.g., excessive acquisition of protected content without any corresponding payment, usage records without corresponding billing records).

However, as explained above, detecting "patterns of use that may or do indicate fraud" as described in Ginter is not the same as detecting "patterns of payments" and "comparing said patterns of payments to predetermined patterns of payments" as recited in claim 1. Rather, as made clear by Ginter's goal of detecting "acquisition of protected content without any corresponding payment" (*Id.*, emphasis added), detecting "patterns of use" does not mean that there has been a corresponding payment, and hence "patterns of use" is not the same thing as "patterns of payments." This makes sense given that Ginter is concerned with preventing access to content before payment for the access is made, while applicants' claim 1 includes a comparison of payment patterns to predetermined payment patterns (e.g., to detect an attack on a system).

Therefore, Ginter does not show or suggest a method for monitoring accesses to a resource including, among other things, "comparing [detected] patterns of payments to predetermined patterns of payments" as claimed in independent claim 1.

In light of the foregoing, applicants respectfully submit that independent claim 1 is allowable over Ginter. Moreover, because independent claim 1 is allowable, claim 2 depending therefrom is also allowable. Therefore, applicants respectfully request that the rejection of claims 1 and 2 under 35 U.S.C. § 102(e) be withdrawn by the Examiner.

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<sup>3</sup> On page 4 of the Office Action, the Examiner referred to "column, lines 11-23, i.e. 'Such checks ... without any corresponding payment.'" Based on applicants review of the text in Ginter, it is believed that the Examiner was in fact referring to column 227, lines 11-23 of Ginter.

**IV. Petition for Extension of Time**

Applicants have submitted herewith a petition for a three-month extension of time for responding to the Office Action mailed on January 13, 2005. The Director is hereby authorized to charge any additional fees which may be required for this response, or credit any overpayment, to deposit account no. 08-0219.

**V. Conclusion**

Applicants respectfully submit that, as described above, the cited reference does not show or suggest the combination of features recited in the claims. Applicants do not concede that the cited reference shows any of the elements recited in the claims. However, applicants have provided specific examples of elements in the claims that are clearly not present in the cited reference.

Applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, applicants assert that it is the combination of elements recited in each of the claims, when each claim is interpreted as a whole, which is patentable. Applicants have emphasized certain features in the claims as clearly not present in the cited reference, as discussed above. However, applicants do not concede that other features in the claims are found in the prior art. Rather, for the sake of simplicity, applicants are providing examples of why the claims described above are distinguishable over the cited reference.

Further, applicants hereby retract any arguments and/or statements made during prosecution that were rejected by the Examiner during prosecution and/or that were unnecessary to obtain allowance, and only maintain the arguments that persuaded the Examiner with respect to the allowability of the patent claims, as one of ordinary skill would understand from a review of the prosecution history. That is, applicants specifically retract statements that one of ordinary skill would recognize from reading the file history were not necessary, not used and/or were rejected by the Examiner in allowing the patent application.

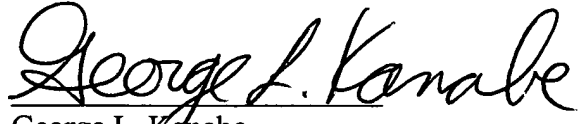
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For at least the reasons set forth above, applicants respectfully submit that this application is in condition for allowance. Reconsideration and prompt allowance of the application are respectfully requested.

Respectfully submitted,

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